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Erich D. Hemm 47,286
Name of Attorney or Agent Registration No.

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P&G Case 6586R

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of :
Michael Kenneth Cerreta, et al. : Confirmation No. 9009
Serial No. 08/914,743 : Group Art Unit: 1623
Filed: August 19, 1997 : Examiner: White, Everett

**COPY OF PAPERS
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For A FLOWABLE NONDIGESTIBLE OIL AND PROCESS FOR MAKING

BRIEF ON APPEAL

Assistant Commissioner for Patents
Washington, D.C. 20231

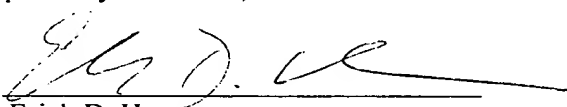
Dear Sir:

Enclosed, pursuant to 37 CFR 1.192(a), is Appellant's brief on Appeal for the above application. The Brief is being forwarded in triplicate.

Please charge the fee of \$320.00 pursuant to 37 CFR 1.17(c) to Deposit Account No. 16-2480 for the filing of the brief in support of an appeal. The Commissioner is also authorized to charge any additional fees which may be required to this account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

By

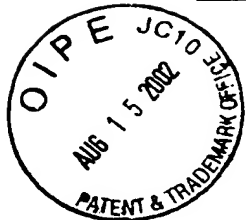

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Date: August 8, 2002

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Name of Attorney Registration No.
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#25
8-21-02
D. J. D. J.
Case 65863

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of :
Michael Kenneth Cerreta :
Peter Yau-Tak Lin :
Penelope Marie Edwards :
Mark Lewis Agerton :
Serial No.: 08/914,743 : Group Art Unit: 1623
Filed: August 19, 1997 : Examiner: E. White
For: A FLOWABLE NONDIGESTIBLE OIL :
AND PROCESS FOR MAKING :

APPEAL BRIEF

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicants hereby appeal to the Board of Appeals the decision of the Examiner dated June 13, 2001, and as modified in the Advisory Action dated February 11, 2002, finally rejecting Claims 1-19 and 41-54. A response to the final rejection was filed.

Real Party in Interest:

The real party in interest is the Procter & Gamble Company, assignee of Appellants' entire right, title, and interest in the invention at issue.

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Related Appeals and Interferences:

Appellants, Appellants' legal representative, and Appellants' assignee are not aware of any other appeals or interferences which will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending appeal.

Status of Claims:

Claims 1-19 and 41-54 have been rejected under 35 U.S.C. §103(a) as unpatentably obvious over Elsen et al. (U.S. Patent No. 5,422,131).

Status of Amendments:

Amendments have been filed subsequent to final rejection. The Examiner entered the Amendments.

Summary of Invention:

The present invention is directed to flowable nondigestible oil compositions comprising a liquid polyol fatty acid polyester having a complete melt point of less than about 37° C., and a crystallized solid polyol fatty acid polyester having a complete melt point of at least about 37° C. The solid polyol fatty acid polyester comprises a plurality of crystallized particles which preferably includes a solid saturated polyol polyester, within the liquid polyol fatty acid polyester. The flowable, nondigestible oil compositions have a Consistency (K) within the temperature range of 20° C to 40° C of less than about 50 P·sec (n-1). The compositions of this invention are capable of being handled and stored in a flowable state at room and ambient storage temperatures, thereby avoiding exposure of the compositions to high temperatures (generally greater than 50° C.) which would otherwise be required to make such compositions flowable prior to use. The ability to use ambient handling and storage conditions for the compositions herein tend to minimize the effects of heat and high temperatures on the chemical stability of the polyol fatty acid polyester, which results in greater oxidative stability and flavor stability during

extended storage of both the nondigestible oil compositions herein and the food products containing the nondigestible oil compositions.

The present invention is also directed to a process for making flowable, nondigestible oil compositions. The process comprises the steps of (1) completely melting the nondigestible oil composition containing the solid polyol fatty acid polyester and the liquid polyol fatty acid polyester, (2) crystallizing the solid polyol polyester into a plurality of crystallized particles, preferably in two crystallization steps or stages; and (3) shearing the polyol polyester composition during the step of crystallizing the solid polyol fatty acid polyester.

Issues:

Whether Claims 1-19 and 41-54 are patentable over Elsen et al. (U.S. Patent No. 5,422,131).

Grouping of Claims:

The claims stand or fall together.

The Argument:

To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Examiner. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-19 and 41-54 have been rejected under 35 U.S.C. §103(a) as being unpatentably obvious in view of Elsen et al. (U.S. Patent No. 5,422,131). The Examiner contends that it would have been “obvious to one of ordinary skill in the art having the Elsen et al patent before him to obtain the instant claimed nondigestible composition in view of their closely related structures and the resulting expectation of similar organoleptic properties for food prepared with the nondigestible compositions.” Applicants respectfully traverse this rejection.

Appellants respectfully submit that this rejection is improper because none of the criteria for establishing a *prima facie* case of obviousness have been satisfied. The rejection is improper because: (1) there is not a reasonable expectation of success of obtaining the claimed invention based upon the references relied upon by the Examiner; (2) there is no suggestion or motivation to modify the references or to combine reference teachings; and (3) the references, even if combined, do not teach or suggest all the claim limitations.

There is not a reasonable expectation of success of obtaining the claimed invention based upon the references:

The present invention is a flowable, nondigestible oil composition having a Consistency (K) within the temperature range of 20° C to 40° C of less than about 50 P-sec (n-1). The cited reference does not teach or suggest the desirability of a nondigestible oil having these characteristics. Rather, Elsen focuses on a nondigestible fat composition which, though comprised of a liquid component and a solid component, is substantially solid at ambient and room temperatures. As recognized by the Examiner, however, nowhere in Elsen is the problem of flowability at ambient temperatures recognized. See paper No. 11, Page X, Lines y-z, wherein the Examiner states that the nondigestible composition encompassed by the instant claims “differ from the nondigestible composition disclosed in the Elsen et al reference in the recitation of the compositions having ‘a Consistency in a temperature range of 20-40°C of less than about 600 P.sec (n-1)’ which is not recited in the Elsen et al. patent.”

References may be modified or combined to reject claims as *prima facie* obvious only if there is a reasonable expectation of success that the claimed invention will result. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Because Elsen does not teach or suggest flowable, nondigestible oil compositions having a Consistency (K) within the temperature range of 20° C to 40° C of less than about 50 P-sec (n-1), one would not reasonably expect to be successful in obtaining such a composition by modifying this reference. Thus, the conclusion that the present invention is obviousness in view of the cited reference is improper.

There is no motivation to modify or combine the references:

Obviousness can only be established by combining or modifying reference teachings to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1491 (Fed. Cir. 1992). As noted *supra*, Elsen does not address the problem of providing a flowable, nondigestible oil composition, particularly one having a Consistency (K) within the temperature range of 20° C to 40° C of less than about 50 P-sec (n-1). Thus, because the cited reference does not teach or suggest the desirability of a nondigestible oil composition having these characteristics, there is no motivation to modify the reference to obtain the claimed invention.

One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to duplicate the claimed invention. *In re Fine, supra*. Rather, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). In the present case, no such reason for modifying the cited reference can be found. Thus, the modification of the reference, and the conclusion that the present invention is obvious in view of it, is improper.

The references do not teach or suggest all the claim limitations:

The present invention requires that the flowable, nondigestible oil compositions have a Consistency (K) of less than about 50 P-sec (n-1) within the temperature range of 20° C to 40° C. As recognized by the Examiner, however, the cited reference does not teach a flowable composition, much less one with a Consistency (K) of less than about 50 P-sec (n-1). Though Elsen does teach a nondigestible composition comprised of solid and a liquid portions, there is no indication that the claimed flowability characteristic would necessarily result after these ingredients are combined.

To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In the present case, even if modified, the cited reference does not teach or suggest all the elements of the claimed invention. Because all the claim limitations are not taught or suggested by the reference, the conclusion of obviousness is improper.

Given the foregoing considerations, it is respectfully submitted that the Elsen et al reference does not teach or obviously suggest the essential elements of Applicant's flowable nondigestible oil compositions or the processes of making the same. Accordingly, rejection of Applicants amended Claims 1-19 and 41-54 over this reference, under 35 USC §103(a) is improper and should be withdrawn.

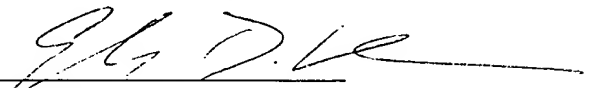
Conclusion:

For the reasons set forth above, Appellants submit that the present invention is not unobvious in view the cited reference. Thus, reversal of the finding of obviousness is respectfully requested.

Respectfully submitted,

For: Cerreta et al.

By



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August 8, 2002

APPENDIX

1. (Thrice Amended) A flowable nondigestible oil composition comprising a liquid polyol fatty acid polyester having a complete melt point less than 37°C, and a crystallized solid polyol fatty acid polyester having a complete melt point of at least about 37°C, said solid polyol fatty acid polyester comprising a plurality of crystallized spherulites comprising a solid saturated polyol polyester within the liquid polyol fatty acid polyester, wherein particles of said crystallized solid polyol fatty acid polyester have a diameter of from about 1 microns to about 50 microns, and wherein the flowable nondigestible oil composition has a Consistency in a temperature range of 20-40°C in the range of from about 0 P.sec(n-1) to about 30 P.sec(n-1), and wherein the solid polyol fatty acid polyester is crystallized while shearing the nondigestible oil.

2. (Thrice Amended) A flowable nondigestible oil composition comprising a liquid polyol fatty acid polyester having a complete melt point less than 37°C, and a crystallized solid polyol fatty acid polyester having a complete melt point of at least about 37°C, said solid polyol fatty acid polyester comprising a plurality of crystallized spherulites comprising a solid saturated polyol polyester within the liquid polyol fatty acid polyester, wherein particles of said crystallized solid polyol fatty acid polyester have a diameter of from about 1 microns to about 50 microns, and wherein the flowable nondigestible oil composition has a Consistency in a temperature range of 20-40°C in the range of from about 0 P.sec(n-1) to about 30 P.sec(n-1), and wherein the solid polyol fatty acid polyester is crystallized in less than about 5 hours.

3. The flowable composition according to Claim 1 wherein the crystallized solid polyol fatty acid polyester further comprises a plurality of crystallized aggregated spherulites comprising a core comprising a solid saturated polyol polyester, and surrounded by crystallized aggregate particles crystallized to the spherulite comprising a solid diversely esterified polyol polyester.

4. The flowable composition according to Claim 3 wherein the solid polyol fatty acid polyester is crystallized in less than about 2 hours.
5. The flowable composition according to Claim 1 wherein the solid polyol fatty acid polyester further comprises aggregate particles comprising the solid diversely esterified polyol polyester.
6. The flowable nondigestible oil composition of Claim 1 comprising, by weight, 50-99% of the liquid polyol fatty acid polyester, and 1-50 % of the solid polyol fatty acid polyester.
7. (Twice Amended) The flowable nondigestible oil composition according to Claim 1 wherein the Consistency in a temperature range of 20°-40°C is in the range of from about 0 P.sec(n-1) to about 25 P.sec(n-1).
8. (Twice Amended) The flowable nondigestible oil composition according to Claim 3 wherein the Consistency in a temperature range of 20°- 40°C is in the range of from about 0 P.sec(n-1) to about 20 P.sec(n-1).
9. (Twice Amended) The flowable nondigestible oil composition according to Claim 7 wherein the Consistency in a temperature range of 20°-40°C is in the range of from about 0 P.sec(n-1) to about 20 P.sec(n-1).
10. (Twice Amended) The flowable nondigestible oil composition according to Claim 8 wherein the Consistency in a temperature range of 20°-40°C is in the range of from about 0 P.sec(n-1) to about 10 P.sec(n-1).
11. (Twice Amended) The flowable nondigestible oil composition according to Claim 9 wherein the Consistency in a temperature range of 20°-40°C is in the range of from about 0 P.sec(n-1) to about 10 P.sec(n-1).
12. The flowable nondigestible oil composition according to Claim 1 wherein the solid saturated polyol polyester has a complete melt point of at least about 60 °C.

13. The flowable nondigestible oil composition according to Claim 3 wherein solid saturated polyol polyester is selected from hepta-substituted saturated fatty acid polyol polyester, octa-substituted saturated fatty acid polyol polyester, and mixtures thereof, having C20-C24 saturated fatty acid radicals, and wherein the solid diversely esterified polyol polyester is selected from hepta-substituted diversely esterified polyol polyester, octa-substituted diversely esterified polyol polyester, and mixtures thereof, having fatty acid radicals comprising a) long chain saturated fatty acid radicals, and b) dissimilar fatty acid radicals which are dissimilar from the long chain saturated fatty acid radicals and are selected from the group consisting of i) long chain unsaturated fatty acid radicals, ii) short chain saturated fatty acid radicals, and iii) mixtures thereof.

14. The flowable nondigestible oil composition according to Claim 13 wherein the solid saturated polyol polyester comprises at least 5% by weight sucrose octasaturate.

15. (Amended) The flowable nondigestible oil composition according to Claim 13 wherein the crystallized aggregated spherulites have a maximum dimension of from about 3 microns to about 32 microns.

16. The flowable nondigestible oil composition according to Claim 13 further comprising temperature-sensitive food additives.

17. (Amended) The flowable nondigestible oil composition according to Claim 13 wherein the solid saturated polyol polyester comprises octa-behenate sucrose polyester, and wherein the solid diversely esterified polyol polyester comprises sucrose polyester wherein the esters are selected from behenate and a mixture of oleate and linoleate unsaturate.

18. The flowable nondigestible oil composition according to Claim 13 wherein the solid polyol fatty acid polyester has fatty acid esters comprising long chain saturated fatty acid esters and long chain unsaturated fatty acid esters in a ratio thereof of from 5:3 to about 7:1.

19. The flowable nondigestible oil composition according to Claim 18 wherein the ratio of long chain saturated fatty acid esters to long chain unsaturated fatty acid esters is from about 6:2 to about 6.5:1.5.

41. (Thrice Amended) A flowable nondigestible oil composition comprising a liquid polyol fatty acid polyester having a complete melt point of a less than about 37°C, and a solid polyol fatty acid polyester having a complete melt point of at least about 37°C, wherein the solid polyol fatty acid polyester is in the form of crystallized spherulitic particles, wherein said crystallized spherulitic particles have a diameter of from about 1 microns to about 50 microns, and wherein the flowable nondigestible oil composition has a Consistency in a temperature range of 20-40°C in the range of from about 0 P.sec(n-1) to about 30 P.sec(n-1).

42. (Twice Amended) The flowable nondigestible oil composition according to Claim 41 wherein the Consistency is in the range of from about 0 P.sec(n-1) to about 25 P.sec(n-1).

43. The flowable nondigestible oil composition according to Claim 41 wherein the solid polyol fatty acid polyester is selected from the group consisting of (i) a solid saturated polyol polyester and (ii) combinations of solid saturated polyol polyester with a solid diversely esterified polyol polyester; a polyol polyester polymer; or combinations of said diversely esterified polyol polyester and said solid polyester polymer.

44. The flowable nondigestible oil composition according to Claim 43 wherein solid polyol fatty acid polyester comprises a solid saturated polyol polyester and a solid diversely esterified polyol polyester.

45. The flowable nondigestible oil composition according to Claim 44 wherein the solid saturated polyol polyester and the solid diversely esterified polyol polyester are in the form of co-crystallized particles.

46. The flowable nondigestible oil composition of Claim 41 comprising, by weight, 50-99% of the liquid polyol fatty acid polyester, and 1-50 % of the solid polyol fatty acid polyester.

47. The flowable nondigestible oil composition according to Claim 41 wherein the crystallized particles have a maximum dimension of from about 1 micron to about 30 microns.

48. The flowable nondigestible oil composition according to Claim 44 wherein solid saturated polyol polyester is selected from hepta-substituted saturated fatty acid polyol polyester, octa-substituted saturated fatty acid polyol polyester, and mixtures thereof, having C20-C24 saturated fatty acid ester moieties, and wherein the solid diversely esterified polyol polyester is selected from hepta-substituted diversely esterified polyol polyesters, octa-substituted diversely esterified polyol polyesters, and mixtures thereof, having fatty acid ester moieties comprising a) long chain saturated fatty acid ester moieties, and b) dissimilar fatty acid ester moieties which are dissimilar from the long chain saturated fatty acid ester moieties and are selected from the group consisting of i) long chain unsaturated fatty acid ester moieties, ii) short chain saturated fatty acid ester moieties, and iii) mixtures thereof.

49. The flowable nondigestible oil composition according to Claim 48 wherein the solid sucrose polyester comprises at least 5% by weight sucrose octabehenate.

50. The flowable nondigestible oil composition according to Claim 41 wherein the solid sucrose polyester has a complete melt point of a minimum of about 60 °C.

51. The flowable nondigestible oil composition according to Claim 48 wherein the solid saturated polyol polyester comprises octa-behenate sucrose polyester, and wherein the solid diversely esterified polyol polyester comprises octa-saturated sucrose polyester wherein the esters are selected from behenate and a mixture of oleate and linoleate.

52. The flowable nondigestible oil composition according to Claim 48 wherein the solid polyol fatty acid polyester has fatty acid ester moieties comprising long chain saturated fatty acid ester moieties and long chain unsaturated fatty acid ester moieties in a ratio thereof of from 5:3 to about 7:1.

53. The flowable nondigestible oil composition according to Claim 48 wherein the ratio of long chain saturated fatty acid esters to long chain unsaturated fatty acid esters is from about 6:2 to about 6.5:1.5.

54. The flowable nondigestible oil composition according to Claim 48 further comprising temperature-sensitive food additives.